

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* ANDREW THOMAS, ROBERT FRANCIS SQUIBBS, MARIANNE HICKEY,  
and PAUL ST. JOHN BRITTAN

Application No. 10/005,909

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER



This application was electronically received at the Board of Patent Appeals and Interferences on March 6, 2006. A cursory review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On September 16, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, a review of the document reveals that the following sections are missing from the Appeal Brief filed September 16, 2005:

- (1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and

(2) "*Related proceedings appendix,*" as set forth in 37 CFR § 41.37(c)(1)(x).

Accordingly, the Appeal Brief does not comply with the new rules under 37 CFR § 41.37(c). It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>

In addition, a Reply Brief was received in the Office on January 17, 2006, in response to the Examiner's Answer mailed November 16, 2005. However, in accordance with the revision effective September 13, 2004, Title 37, Code of Federal Regulations, Section 41.43 states:

(a)(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief . . . .

The application file indicates that the reply brief has not been considered. Written acknowledgment of the reply brief is required to be sent to appellants.

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Further in-depth review reveals that an Amendment under 37 CFR § 1.116 was filed with the Reply Brief on January 16, 2006. 37 CFR § 41.41(a)(2) and § 41.41(b) states that “[a] reply brief shall not include any new or non-admitted amendment,” and that [a] reply brief that is not in compliance with paragraph (a) of this section **will not be considered. Appellant[s] will be notified if a reply brief is not in compliance with paragraph (a) of this section.**” (Emphasis added).

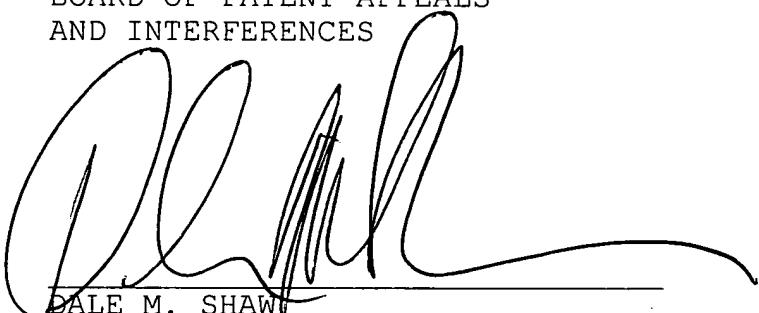
Accordingly, it is

**ORDERED** that the application is returned to the examiner to:

- (1) hold the Appeal Brief filed on September 16, 2005 defective;
- (2) to notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- (3) for the examiner to consider the supplemental Appeal Brief, vacate the Examiner's Answer mailed November 16, 2005 and issue a revised Examiner's Answer in response to the supplemental Appeal Brief;
- (4) have a complete copy of the supplemental Appeal Brief and any subsequent Examiner's Answer scanned into the record;

- (5) provide written notification to appellants as to the status of said Reply Brief **and** Amendment received January 16, 2006 in accordance with 37 CFR §§ 41.41 and 41.43;
- (6) have a complete copy of the written notification scanned into the record; and
- (7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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